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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/836,792	04/17/2001	Ahti Muhonen	309-010118-US(PAR)	6794

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EXAMINER

FOX, BRYAN J

ART UNIT	PAPER NUMBER
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2686

DATE MAILED: 12/22/2003

4

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/836,792

Applicant(s)

MUHONEN, AHTI

Examiner

Bryan J Fox

Art Unit

2686

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 & 3. 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over van den Heuvel, et al. (GB2294844A) in view of Laurila, et al. (US006591116B1).

Regarding claim 1, Van den Heuvel, et al. discloses a communications operating system where a subscriber unit 20 for use in a communications system 19 may be used in multiple different available systems (see figure 1 and page 3, lines 31-34), which reads on the claimed "mobile station, configured for use as a software radio having the capability for universal adaptive use within globally dispersed cellular communication networks". Once the unit has accessed the channel of the common communication system, it receives an indication of available communication systems (see page 4, lines 14-18), which reads on the claimed "transceiver for receiving data over a common

system parameter channel" and this information may provide details such as features available (see page 4, lines 18-20), which reads on the claimed "processor for compiling and storing network characteristic data, received over said common system parameter channel, relating to the operational capabilities of said network". Furthermore, the system uses a matrix having features cross-referenced by subscriber unit capabilities, which reads on the claimed "combining said network characteristic data and said subscriber identification data into an addressable matrix of operational capabilities". The system disclosed by van den Heuvel, et al. fails to teach that the subscriber unit will store identification information.

Laurila, et al. discloses a system where the module, in the form of a circuit card, stores information for specifying at least an identification and the operational capabilities of the module in each of the plurality of different networks (see column 3, lines 19-23), which reads on the claimed "processor for compiling and storing subscriber identification data relating to the operational capabilities of said mobile station".

It would have been obvious to one skilled in the art at the time of the invention to modify van den Heuvel, et al. with Laurila, et al. to include the above card that stores identification and operational information in order to eliminate the need for the system to store such information.

The only difference between the above combination and the claimed invention is that the compiling the system information and the matrix is done at the system in the above combination but in the claimed invention it is done in the mobile unit. However, that difference in the location of the compilation would not render the invention

patentable over the above references. Therefore, it would have been obvious to one skilled in the art at the time of the invention modify the combination of van den Heuvel, et al. and Laurila, et al. to include compilation of the information on the unit in order to save processing time on the system.

Regarding claim 8, Van den Heuvel, et al. discloses a communications operating system where a subscriber unit 20 for use in a communications system 19 may be used in multiple different available systems (see figure 1 and page 3, lines 31-34), which reads on the claimed "mobile station, configured for use as a software radio having the capability for universal adaptive use within globally dispersed cellular communication networks". Once the unit has accessed the channel of the common communication system, it receives an indication of available communication systems (see page 4, lines 14-18), which reads on the claimed "receiving data over a common system parameter channel" and this information may provide details such as features available (see page 4, lines 18-20), which reads on the claimed "compiling and storing network characteristic data, received over said common system parameter channel, relating to the operational capabilities of said network". Furthermore, the system uses a matrix having features cross-referenced by subscriber unit capabilities, which reads on the claimed "combining said network characteristic data and said subscriber identification data into an addressable matrix of operational capabilities". The subscriber unit determines which system it desires to utilize based on the list of available systems, types of features available and system costs (see page 3, lines 31-36), which reads on the claimed "generating an operational configuration based on said matrix". The system

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disclosed by van den Heuvel, et al. fails to teach that the subscriber unit will store identification information.

Laurila, et al. discloses a system where the module, in the form of a circuit card, stores information for specifying at least an identification and the operational capabilities of the module in each of the plurality of different networks (see column 3, lines 19-23), which reads on the claimed "compiling and storing subscriber identification data relating to the operational capabilities of said mobile station".

It would have been obvious to one skilled in the art at the time of the invention to modify van den Heuvel, et al. with Laurila, et al. to include the above card that stores identification and operational information in order to eliminate the need for the system to store such information.

The only difference between the above combination and the claimed invention is that the compiling the system information and the matrix is done at the system in the above combination but in the claimed invention it is done in the mobile unit. However, that difference in the location of the compilation would not render the invention patentable over the above references. Therefore, it would have been obvious to one skilled in the art at the time of the invention to compile the information on the unit in order to save processing time on the system.

Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over van den Heuvel, et al. in view of Laurila, et al. and further in view of Henry, Jr, et al. (US005603084A).

Regarding claim 3, the combination of van den Heuvel, et al. and Laurila, et al. fails to teach that a portion of the characteristics are programmed at the time of manufacture.

Henry, Jr, et al. teaches that the programming of the serial number and the initial identification number can be accomplished when the phone is manufactured (see column 4, lines 4-7), which reads on the claimed invention that a portion of said operational characteristics of said mobile station are programmed into the device at the time of manufacture.

It would have been obvious to one skilled in the art at the time of the invention to modify the combination of van den Heuvel, et al. and Laurila, et al. with Henry, Jr, et al. to program the serial number during manufacturing in order to eliminate the need to use time to do that later.

Regarding claim 4, the combination of van den Heuvel, et al. and Laurila, et al. fails to teach that a portion of the characteristics are programmed when the device is activated.

Henry, Jr, et al. teaches that some information is programmed after purchase and before a user can place a call, which reads on the claimed invention that a portion of said operational characteristics of said mobile station are programmed into the device at the time of activation with a home cellular service.

It would have been obvious to one skilled in the art at the time of the invention to modify the combination of van den Heuvel, et al. and Laurila, et al. with Henry, Jr, et al.

to include programming at the time of activation in order to allow information that is dependent on the customer to be input into the phone, such as a credit limit.

Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of van den Heuvel, et al. and Laurila, et al. in view of Henry, Jr, et al., and further in view of Retzer, et al. (US006009325A).

Regarding claims 5 and 6, the combination of van den Heuvel, et al, Laurila, et al. and Henry, Jr, et al. fails to teach the use of a ROM inside of the cellular telephone.

Retzer, et al. teaches the use of an EEPROM 207 (electrically erasable programmable read-only memory) in a wireless device (see column 2, lines 60-66 and figure 2), which reads on the claimed "read only memory for storing said operational characteristics of the mobile station".

It would have been obvious to one skilled in the art at the time of the invention to modify the combination of van den Heuvel, et al, Laurila, et al. and Henry, Jr, et al. with Retzer, et al. to include the above EEPROM in order to have a re-programmable memory that is quickly accessed.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of van den Heuvel, et al. and Laurila, et al. as applied to claim 1 above, and further in view of Retzer, et al.

Regarding claim 7, the combination of van den Heuvel, et al. and Laurila, et al. fails to teach the use of an erasable, programmable read only memory.

Retzer, et al. teaches the use of an EEPROM 207 (electrically erasable programmable read-only memory) in a wireless device (see column 2, lines 60-66 and figure 2), which reads on the claimed "erasable, programmable read only memory".

It would have been obvious to one skilled in the art at the time of the invention to modify the combination of van den Heuvel, et al. and Henry, Jr, et al. with Retzer, et al. to include the above EEPROM in order to have a re-programmable memory that is quickly accessed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryan J Fox whose telephone number is (703) 305-8994. The examiner can normally be reached on Monday through Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on (703) 305-4379. The fax phone number for the organization where this application or proceeding is assigned is (703) 746-9802.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

BJF

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